

## **REMARKS**

The present amendment is in response to the Advisory Action dated March 22, 2007, where the Examiner has maintained a rejection of claims 36-55. The Examiner indicated in the Advisory Action that a response to a Final Office Action by Applicant dated February 28, 2007 has not been entered. In the Advisory Action, the Examiner maintained the rejection in the Final Office Action dated December 27, 2006. The current reply includes the amendments not entered by the Examiner and addresses the points raised in both the Final Office Action and the Advisory Action.

In the present amendment, claims 36, 38, 45, and 47 have been amended and claims 56-62 have been added. Accordingly, claims 36-62 are pending in the present application with claims 36, 38, 45, and 56 being the independent claims. Reconsideration and allowance of pending claims 36-62 in view of the amendments and the following remarks are respectfully requested.

### **A. Claim Objections**

The Examiner rejected claim 47 due to informalities. Applicant has amended claim 47 to remove the informalities. Applicant submits that the objection to claim 47 should now be withdrawn.

### **B. New Matter**

In the Advisory Action, the Examiner indicated that Applicant's amendments to claims 36, 38, and 45 have no support in the specification. Applicant asserts that the present amendment does not add new matter. The present amendment adds the following limitations to the claims.

In claim 36 the following limitation is added: "the user storing a specific activity associated with the at least one target location in the memory before entering the target range." In claim 38 the following limitation is added: "at least one output interface for outputting an indication of the specific task when the current location of the wireless communications device is proximate to one of the physical locations of the plurality of physical locations wherein the specific task is stored in

the memory before the wireless communications device is proximate to the one of the physical locations." In claim 45 the following limitation is added: "a user input device for inputting the each target location and for inputting the each target message before the wireless device is within the range area."

All of the added limitations are supported by the specification as follows. In general, the specification supports a two-step process. First, the mobile phone is set up and second, the mobile phone is used. For example, in the summary of the invention on page 2, lines 19-22 the specification states: "If the determined present location of the wireless communication device is within a particular target range area corresponding to a particular target location, the wireless communication device provides a target response that was programmed in the wireless communication device . . ." Clearly this passage describes a sequence. Namely, the target response was programmed into the device before the device was used (i.e., before there is a determination that the wireless communication device is within a particular target range area requiring a response).

Likewise on page 5, lines 16-18, the present Application states that "the range area, the target location, and the target response (e.g., displaying a message) have previously been programmed by the user of the wireless communication device 120." What had previously been programmed is a target response of "buy milk" that appears when the user enters the range area. (See, Page 5, Lines 9-18 of the present Application). Again, the previous programming could have occurred at home, in another state, or in another country, but it is clear that the device was programmed before coming into proximity with the grocery store (e.g., the target range, the specific location, or the range area).

Figures 4 through 5 also support the logical order that the user programs the device before using it by entering a target area. In Figure 4, a flowchart is shown for storing a new target. This occurs, for example, by the user utilizing a map or entering coordinates. (See, Page 9, Lines 17-20 of the present Application). The process in Figure 4 can be carried out on the wireless device itself or a personal computer. (See, Page 11, Lines 1-4 of the present Application). Figure 5 shows a process for checking whether the wireless device is in a target range. Figure 5 could not take

place had Figure 4 not been carried out beforehand, otherwise there would be no programmed target response for anything to happen on the device when the target range was entered. For the above reasons, the amendments to claims 36, 38, and 45 are supported by the specification and do not add new matter, and should be entered.

**C. Rejection of Claims 36-45 Under 35 U.S.C. 103**

In a Final Office Action dated December 27, 2006, claims 36-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,198,390 issued to Schlager ("Schlager") in view of US Patent Number 6,091,956 issued to Hollenberg ("Hollenberg").

With regard to independent claims 36 and 38, the Examiner states that Schlager teaches the limitations of claims 36 and 38, but does not teach "the user storing a specific activity associated with the at least one target location" and "outputting an indication of the specific activity associated with the at least one target location." The Examiner further states that Hollenberg teaches these limitations. The Examiner states that the combination of Schlager and Hollenberg makes the claimed invention obvious. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a prima facie case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

**1. Suggestion or Motivation to Combine**

The subject matter of the amended claims is directed to location-based responses to a user utilizing a wireless communications device, in which the user stores

a specific activity associated with the at least one target location in the memory before the user enters the target area or becomes proximate to the target location. When the user becomes proximate to one of the target locations, the wireless communication device outputs from the memory an indication of the specific activity. (See, independent claims 36 and 38.)

The Schlager reference addresses the use of a separation distance between a device and a target, which can be used for example to sound an alarm. (See, Column 15, Lines 1-16.) The Hollenberg reference operates by receiving information via an antenna and conveying the information (such as an advertising message) to a user display. (See, Column 16, Lines 11-24.)

Schlager fails to disclose any suggestion or motivation for a user to store "a specific activity associated with the at least one target location in a memory, before a user enters a target range," which is included in the independent claims 36 and 38. Merely sounding an alarm, as in Schlager, is not a "specific activity" from a "user" such as identifying a grocery store as a target location, and establishing an output response like "picking up a loaf of bread at the grocery store." Furthermore, Schlager is exactly opposite the claimed invention because the trigger in Schlager is when the device moves away from a target not when a device moves into a target region.

In addition, Hollenberg fails to cure the basic deficiencies of Schlager. In Hollenberg, displaying an advertisement when a user enters a certain area or enters a store is still not a "specific activity" from a "user." Even assuming *arguendo* that an advertisement popping up on a user display at a certain location was a "specific activity," Hollenberg fails to teach storing of the advertisement "in the memory" of the wireless communication device before the user became proximate to the store.

By Hollenberg's very nature, each advertisement must be received via an antenna as the user enters an area proximate to a store where the advertisement would become pertinent. (See, Column 16, Lines 11-24.) Modifying Hollenberg such that all advertisements are pre-stored in the memory is nowhere disclosed or even suggested because such a modification would create too much data to be stored in any individual handheld device due to the limited memory resources of such a device. For that

reason, receiving the advertisements via an antenna on the fly, as disclosed by Hollenberg, teaches away from the proposed combination and, as such, there is no suggestion or motivation to combine Schlager with Hollenberg.

## 2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited the prior art reference points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis. For example, Applicant notes that the Examiner admits that Schlager does not teach a specific activity associated with a target location. (See, Page 3 of the Office Action.)

Applicant asserts that Hollenberg does not teach this limitation either. However, even if Hollenberg did teach this limitation, one could not reasonably expect to succeed by combining the two references because Hollenberg requires that the advertisement be received via an antenna after the user becomes proximate to the target range or target area. (See, Column 16, Lines 11-24.) Even if Schlager could be combined with Hollenberg, the user specific activities that are presently claimed would have to be transmitted to the wireless device after the user entered the target range. This would waste bandwidth, it would increase latency, and it is contrary to the wording of the current claims.

Similarly, it would be impossible to put all of the possible advertisements into the memory of a wireless device in advance of entering the target range because there are too many advertisements, they change too often, and the wireless device has limited resources. In fact, the present application specifically avoids the drawbacks that would occur if the user specific activities were not put into memory beforehand. These are the very same drawbacks that would hinder the expectation of success of the proposed combination, if it were possible to combine Schlager with Hollenberg.

## 3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claimed invention. For example, the present claims 36 and 38 (the wording is slightly different for each claim) provide that the user stores a "specific activity" associated with the at least one target location in the memory "before approaching the target range."

Schlager discloses self-locating remote monitoring systems in which a base station receives information from the remote device to determine appropriate actions, such as sounding alarms (See, Column 7, Lines 5-10.) For example, in FIG. 16, geographical regions and boundaries are stored in the storage circuits 410, and serve as one input to the comparator 412 (FIG. 13). The comparator 412 also receives the location output 432 from the navigational receiver 406. The comparator 412 compares the location of the remote unit 402 with the defined geographical region and defines a relationship between the location and the defined region, which is expressed as a positional status. For the first example, the location is "within a defined geographical region" or "outside the defined geographical region." The comparator 412 defines a positional status that "the location of the remote unit relative to the defined region is acceptable" or "the location of the remote unit relative to the defined region is not acceptable." This positional status is then transmitted to the base station 404 and will or will not result in activation of an alarm 430.

For a next example, three successive locations 498, 500 and 502 are an "acceptable", a "warning" or a "prohibited" subregion in Schlager. In another embodiment, no enforcement or warning are given by the remote unit 402. Instead, as when used to monitor the movements of children or elderly patients, the positional status is transmitted to the base station 404 for a determination of a positional status.

Regardless of the nature of the subregions in Schlager, the teaching is to, for example, sound an alarm or not sound an alarm. Such a sounding or not sounding of an alarm is not a "specific activity" defined by a user. It is merely an alarm that is not specific, not changeable, and not defined by the user.

Hollenberg, on the other hand, receives information via an antenna and conveys the information (such as an advertising message) to a user display. (See, Column 16, Lines 11-24). The purpose of the antenna in Hollenberg is to receive input data when the user enters the target range. As such, Hollenberg does not store the advertisement it provides "before the user becomes proximate to the target range." Since the combination of references does not include all the limitations of the invention in claims 36-44 and 50-52, the Applicant requests that the rejection be withdrawn.

**D. Rejection of Claims 45-49 and 53-55 Under 35 U.S.C. 102**

Claims 45-49 and 53-55 are rejected as anticipated under 35 U.S.C. 102(b) based on Schlager. Applicant has amended independent claim 45. Applicant asserts that Schlager does not teach, suggest, or describe “a user input device for inputting the each target location and for inputting the each target message before the wireless device is within the range area.”

Schlager teaches self-locating remote monitoring systems in which a base station receives information from a remote device to determine its location and sound an alarm. (See, Column 7, Lines 5-10.) For example, in FIG. 16, geographical regions and boundaries are stored in the storage circuits 410, and serve as one input to the comparator 412 (FIG. 13). The comparator 412 also receives the location output 432 from the navigational receiver 406. The comparator 412 compares the location of the remote unit 402 with the defined geographical region and defines a relationship between the location and the defined region, which is expressed as a positional status. This positional status is then transmitted to the base station 404 and will or will not result in activation of an alarm 430.

Activating an alarm based on a positional status is not a “target message” that is input by a user as claimed by Applicant. That is, a warning as taught by Schlager does not prompt the user to perform a user-stored specific activity as claimed by Applicant nor is it input before the user enters the target area. Therefore, Schlager clearly does not disclose the claimed invention.

As such, Applicant asserts that Schlager does not anticipate the independent claim 45. Additionally, Applicant respectfully asserts that Schlager does not disclose each and every element of the claim 45 as further discussed below. Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for the pending independent claim 45 and its respective dependent claims 46-49 and 53-55.

**E. Rejection of Claims 50-52 Under 35 U.S.C. 103**

In the Office Action, claims 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlager. With regard to claim 50, the Examiner states that Schlager teaches the limitations of claims 50, but does not teach that the wireless

communications device is a laptop, a pager, or a PDA. The Examiner further states that such limitations are obvious based on Schlager. With regard to claim 52, the Examiner states that Schlager teaches the limitations of claims 52, but does not teach that target range area is two-dimensional or three-dimensional space. The Examiner further states that such limitations are obvious based on Schlager.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a prima facie case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

#### 1. Suggestion or Motivation to Modify

The arguments presented with respect to the obviousness rejection of independent claims 36 and 38 also apply to independent claim 45, upon which the currently rejected claims 50 and 52 depend. The subject matter of presently claimed in claim 45 is for location-based responses to a user utilizing a wireless communications device, in which the user stores a specific activity or a "target message" associated with the at least one target location in the memory before the user enters or becomes proximate to the range area associated with the target location.

The Schlager reference addresses the use of a separation distance between a device and a target, which can be used for example to sound an alarm. (See, Column 15, Lines 1-16). Schlager fails to create a suggestion or a motivation for a user to store "a target message associated with the at least one target location in a memory, before a user enters a target range," which is included in the independent claims 45. Merely sounding an alarm, as in Schlager, is not a "target



message" from a "user" such as identifying a grocery store as a target location, and establishing an output response like "picking up a loaf of bread at the grocery store."

The Examiner cites no suggestion or motivation to modify Schlager to output a target message to a user when the user is in a target range where the message is input before the user enters the target range. Furthermore, there is no suggestion or motivation to use a laptop, PDA, or pager as the target device and no suggestion to define the target range in 2-D or 3-D space.

## 2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited the prior art reference points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis. For example, Schlager does not teach a user defined, target message associated with a target range, and the Examiner does not demonstrate that Schlager could be successfully modified to perform that limitation with respect to claim 45. As such, there is also no reasonable expectation of success to perform the limitation on a laptop, PDA, or pager as in claim 50 or in 2-D or 3-D space as in claim 52.

## 3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claimed invention. For example, the present claim 45 provides that the user stores a "target message" associated with the at least one target location in the memory before approaching a range area. Schlager discloses self-locating remote monitoring systems in which a base station receives information from the remote device to determine appropriate actions, such as sounding alarms (See, Column 7, Lines 5-10.)

In Schlager, the teaching is to sound an alarm or not sound an alarm. Such a sounding or not sounding of an alarm is not a "target message" defined by a user. It is merely an alarm that is not specific, not changeable, and not set by the user.

As such, performing the above limitation on a laptop, PDA, or pager as in claim 50 or in 2-D or 3-D space as in claim 52 is also not taught by Schlager. Since the combination of references does not include all the limitations of the invention in claims 50-52, the Applicant requests that the rejection be withdrawn.

**F. Conclusion**

For all the foregoing reasons, allowance of claims 36-62 pending in the present application is respectfully requested. Payment of the issue fee and the fee for a one-month extension for period of reply accompanies the present submission. No other fee is believed due. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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